

REMARKS

This is a Response to the Office Action dated November 9, 2007. After entry of this Reply, claims 14-19 and 22-28 are pending in the application. In this response and amendment, claims 27 and 28 are added. Applicants believe that the Application is in condition for allowance.

Claim Rejections- 35 USC § 102

In the Office Action, the Examiner maintains the rejection of claims 14-18 and 22-23 under 35 USC §102(b) over Czerwinski (US 4552909) as evidenced by Hawley's article on Polyvinyl Acetate. Applicants respectfully traverse, and contend that the Examiner has not met his burden to show inherency. Accordingly, the burden does not shift to Applicant to show unobvious difference

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Also, "[a]n invitation to investigate is not an inherent disclosure" where a prior art reference "discloses no more than a broad genus of potential applications of its discoveries." (MPEP §2112, IV, ¶2).

For example, the Examiner does not disagree with Applicants that the specific passages of Czerwinski cited by the Examiner in the previous office action (particularly, col. 5, line 62 through col. 6, lines 1-3; and col. 6, lines 43-51) do not anticipate the present invention (Response to Arguments, ¶16). The Examiner, however, indicates that these passages of Czerwinski are not relied upon for the rejection of the claims, and also indicates that the thermosetting polymers disclosed in Czerwinski are not relied upon for the rejection

of the claims (Response to Arguments, ¶17). Rather, the Examiner cites Czerwinski as an alternative embodiment (Claim Rejections, ¶16). In the rejection, the Examiner points to Czerwinski for "all it contains." (Response to Arguments, ¶16, 17).

None of the possible compositions and utilities of Czerwinski (col. 5, line 11 to col. 8, line 66) disclose the thermoplastic binder of the claimed invention. Czerwinski discloses polyvinyl acetate homo-polymer as an example of high molecular weight film-formers (Czerwinski, col. 5, lines 24-29). However, polyvinyl acetate homo-polymer is not a member of the group that defines the thermoplastic binder in component b) of claim 14. Languages discussing other alternative embodiments in Czerwinski are broad and vague. "A prior art reference that discloses a genus still does not inherently disclose all species within that broad category." (MPEP §2112, IV, ¶2). Thus, the general discussion in Czerwinski of alternative embodiments does not inherently anticipate the specific thermoplastic binder of the claimed invention.

Further, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient!'" (MPEP §2112, IV, ¶1)

Czerwinski discloses compositions of polyester resin or other unsaturated resin composition that is dispersed in organic solvents (Czerwinski, col. 5, line 65 to col. 6, line 3, col. 6, lines 43-51). The Examiner hypothesizes that when the solvent is removed from the

Czerwinski compositions, the resulting solid material might anticipate the present invention. Since the removal of the solvent is not disclosed in the prior art reference (Czerwinski), the Examiner relies on the presumed recognition in the art that coatings, adhesives, sealants, and the like harden in the final state. However, the hardening of coatings, adhesives, sealants, and the like in the final state does not necessarily correlate with the complete removal of organic solvent by evaporation, or otherwise. At most, the Examiner provides a mere possibility that in some circumstances an alternative composition of Czerwinski may resemble the composition of the present invention.

Therefore, Applicants respectfully submit that a showing of inherency has not been satisfied to shift the burden to Applicant to prove non-obviousness. The Examiner does not provide a basis in fact and/or technical reasoning to reasonably support a determination that the purportedly inherent characteristic necessarily flows from the teachings of Czerwinski.

Applicants respectfully request withdrawal of the rejection under 35 USC § 102(b) over Czerwinski.

Claim Rejections- 35 USC § 103

The Examiner rejects claim 19 under 35 USC § 103(a) as being unpatentable over Czerwinski in view of Moran (US 4882373). The Examiner also rejects claim 24 under 35 USC § 103(a) as being unpatentable over Czerwinski in view of Klüchler et al. The Examiner further rejects claims 25-26 under 35 USC § 103(a) as being unpatentable over Czerwinski in view of Toyota. Applicants respectfully traverse these rejections. For the reasons detailed above, Applicants submit that the claimed invention is patentable over Czerwinski, and therefore claims 19 and 24-26 are also allowable.

Withdrawal of the rejections is respectfully requested.

Claims Added by this Response and Amendment

Claims 27 and 28 are added by this Response and Amendment. Claims 27 and 28 are dependent on independent claim 14, and are added to more completely cover certain aspects of Applicants' invention. Similar to the reasons detailed above, the recitations of claims 27 and 28 are patentable over the prior art of record. Further, Czerwinski only discloses leather fiber content up to 20% (Czerwinski, col. 5, lines 21-35). The added claims find support throughout the specification, and particularly, at page 6, line 19, through page 7, line 4.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that pending claims 14-19 and 22-28 are allowable, that the application is in condition for allowance, and requests that the Examiner issue an early notice of allowance. The Examiner is invited to call the undersigned attorney in the event a telephone interview will advance prosecution of this application.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of the fees associated with this communication to Deposit Account No. 02-2555.

Respectfully submitted,


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Date: April 3, 2008

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